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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,650	10/30/2003	Vincent Cedric Colnot	PI984	7793
24739 7590 05/12/2009 CENTRAL COAST PATENT AGENCY, INC 3 HANGAR WAY SUITE D WATSONVILLE, CA 95076				
EXAMINER				
GYOREI, THOMAS A				
ART UNIT		PAPER NUMBER		
2435				
MAIL DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/696,650

Applicant(s)

COLNOT, VINCENT CEDRIC

Examiner

Thomas Gyorfi

Art Unit

2435

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 16 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 16 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1, 16, and 23 remain for examination. The correspondence filed 4/27/09 amended claims 1 & 16; added claim 23; and cancelled claims 2-13, 15, & 17-22.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/27/09 has been entered.

Response to Arguments

3. Applicant's arguments with respect to claims 1, 16, and 23 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 16, and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite the limitation(s) "second electronic circuitry connected to one pad of the pad interface not used in the ISO7816 standard configuration, said one pad dedicated as a modulated signal output pad" or an equivalent limitation thereof. However, the specification does not support this limitation. According to the specification, of the eight pads C1-C8 provided to a standard ISO7816 smart card, only pads C4 and C8 are not used in any configuration provided by the standard (see the ISO7816 reference originally entered into the record on 12/1/06, pages 3-4, pads C4 and C8 being reserved for future use, or "RFU"). However, the instant specification teaches that the pad through which the instant invention provides a modulated output signal is done via pad C6 ("Mod": see specification, all of page 3); but the ISO7816 standard teaches that pad C6 already has a standard use: to provide the voltage signal Vpp (ISO7816, Ibid). Thus, the instant specification does not support this limitation wherein the modulated output signal is provided by a pad that is not used in the ISO7816 standard configuration.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 16, and 23 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the claimed invention(s) is drawn to means for an ISO7816 smart card to communicate with another

device, yet the stated purpose of the claimed invention(s) is "to provide security for online transactions." Examiner fails to see how the claimed invention(s) does anything that could even remotely be construed as "providing security for online transactions", as there is no recitation in any of the claims for a computer network of any kind, let alone how the claimed smart card would interact with a network; nor is there any indication that the ability of a smart card to provide a modulated voltage signal on a pad not otherwise used by a standard ISO 7816 compliant smart card provides any security in any meaningful capacity in and of itself.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Worrell et al. (PCT Publication WO 01/06443).

Regarding claims 1 and 16:

Worrell discloses an apparatus and method comprising: a standard ISO7816 eight pad array including a reset pad (Figure 2, and page 3, lines 20-23); onboard components comprising digital storage media (card memory: element 110 of Figure 1, and page 3, lines 16-19), first electronic circuitry compliant with ISO7816 standards and

connected to the pad interface, enabling the card to be used as a conventional smart card (page 3, lines 13-16), second electronic circuitry enabled to generate a modulated voltage signal using data from the storage media (either pad C6 or C7 on an ISO7816 card; pad C8 on an NRSS card: Figure 2, and page 4, lines 19-27), [the second electronic circuitry connected to one pad of the pad interface not used in the ISO7816 standard configuration, said one pad dedicated as a modulated signal output pad (the C8 pad of the NRSS card: Ibid)]; and control circuitry enabled to control functions of the first and second electronic circuitry (element 108 of Figure 1, and page 3, lines 16-19); wherein the control circuitry functions to provide that with the standard ISO7816 reset pad high, no modulated signal output is provided to the dedicated modulated signal output pad, and with the standard ISO7816 reset pad pulled low, the modulated voltage signal is provided to the dedicated modulated signal output pad (when a reset signal is sent to the card, the card does not transfer data but simply responds to confirm whether it is an ISO7816 card or an NRSS card: see all of page 6; cf. the ISO7816 reference, page 6, "RST" and pages 8-9 for a reset signal comprising RST being pulled high).

Allowable Subject Matter

10. Claim 23 is allowable over the prior art, pending resolution of the rejections of the claim under 35 USC 112 as discussed *supra*.
11. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not reasonably teach or suggest the "connector apparatus" by which the smart card is connected to the microphone input of a computer.

Although the previously cited Antebi reference suggests connecting a smartcard to a microphone input of a computer for purposes of establishing data communication, Antebi does not disclose in sufficient detail the precise arrangement of the components of the recited connector apparatus as claimed; nor do any of the other references of record render such an arrangement as obvious.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent 7,508,946 to Yamagata et al.
- U.S. Patent 7,062,584 to Worrell et al.
- U.S. Patent 6,694,399 to Leydier et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Gyorfi whose telephone number is (571)272-3849. The examiner can normally be reached on 8:30am - 5:00pm Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TAG
5/5/09
/Kimyen Vu/
Supervisory Patent Examiner, Art Unit 2435